

PATENT

Attorney Docket No. 05725.0993-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Group Art Unit: 1611
Sandrine DECOSTER et al.)
Application No.: 10/018,769)
Filed: December 21, 2001) Confirmation No.: 2464
For: COMPOSITION CONTAINING AN) VIA EFS-WEB
OPACIFIER OR PEARLESCENT)
AGENT AND AT LEAST TWO FATTY)
ALCOHOLS)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellants present this Reply to the Examiner's Answer dated June 21, 2010. A Request for Oral Hearing is concurrently filed with this Reply Brief.

Appellants do not believe that a fee is due in connection with the filing of this paper. However, if any fees are required in connection with the filing of this paper, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

REMARKS

I. STATUS OF REJECTIONS

In response to the Appeal Brief filed March 29, 2010 ("Appeal Brief"), the Examiner maintained the rejection of claims 18, 20-28, and 30-51 under 35 U.S.C. § 103(a) as being unpatentable over WO 99/13830 to Mitsumatsu et al. ("*Mitsumatsu*") in view of JP401009916A to Oshima ("*Oshima*") and WO 98/03155 to Sebag et al. ("*Sebag*"). See Examiner's Answer of June 21, 2010 ("Answer") at 3.

II. RESPONSE TO EXAMINER'S ARGUMENTS IN THE ANSWER

A. Claims 18, 20-28, and 30-51 Are Patentable Over Mitsumatsu in View of Oshima and Sebag

1. Mitsumatsu Fails to Disclose or Suggest Each and Every Limitation of Appellants' Claimed Invention

In the Answer, the Examiner maintains the rejection of the claims under 35 U.S.C. § 103(a), arguing that the "statement that Mitsumatsu fails to teach or suggest the use of both a C18 fatty alcohol and a C22 fatty alcohol is inaccurate." Answer at 5. Appellants respectfully disagree.

Mitsumatsu does not disclose or suggest at least "[a] cosmetic composition . . . wherein . . . [a] C₁₈ fatty alcohol and [a] C₂₂ fatty alcohol are present in a ratio of 0.15 to 20," a ratio recited in claims 18, 47, 49, and 50. In the Answer, as in the Final Office Action dated May 19, 2009 ("Final Office Action"), the Examiner admits that *Mitsumatsu* "fails to disclose a specifically exemplified formulation comprising stearyl alcohol and behenyl alcohol in the appellant's claimed ratios." Answer at 6.

Yet the Examiner nonetheless argues that Examples 4 and 5 of *Mitsumatsu* "teach[] C18 and C20 alcohols used in a mixture in 1:1 and 1:2 ratio." Answer at 6.

Appellants respectfully submit that this interpretation of Examples 4 and 5 of *Mitsumatsu* is incorrect. Examples 4 and 5 teach compositions containing only stearyl alcohol, with no behenyl alcohol. *Mitsumatsu* at 42. In fact, no example in *Mitsumatsu* teaches a formulation that contains both stearyl alcohol and behenyl alcohol, much less a formulation comprising these two alcohols in Appellants' claimed ratios.¹ The rejection under 35 U.S.C. § 103 is therefore improper and should be reversed.

2. *The Proposed Combination of Mitsumatsu and Oshima Provides No Reasonable Expectation of Success*

A rejection based on an alleged motivation to combine references requires a reasonable expectation of success from the proposed combination. See M.P.E.P. § 2143(G). In the Answer, the Examiner argued that because "Oshima teaches a specific ratio of the fatty alcohols that produces a beautiful appearance, pearl luster and excellent hair-conditioning effect on hair, a skilled artisan obviously had sufficient motivation to apply the amount and ratio of the Oshima's C18 and C22 fatty alcohols to modify the Mitsumatsu teachings with a reasonable expectation of success." Answer at 6. Appellants disagree.

Appellants respectfully submit that the Examiner improperly continues to rely on the teachings of a single reference, *Oshima*, to establish the alleged expectation of success when combining *Oshima* with *Mitsumatsu*. Answer at 6-7. As detailed in the Appeal Brief, the requisite expectation of success must relate to the *combination* of references proposed by the Examiner, rather than to a single reference, and must consider the references in their entirety. Due to the unpredictability associated with

¹ Appellants note that the formulations shown in Examples 4 and 5 do not disclose mixtures of C18 and C22 alcohols as the Examiner argues, but do contain cetyl alcohol and stearyl alcohol used in 1:1 and 1:2 ratios.

modifying the ratio of stearyl alcohol to behenyl alcohol, and because *Mitsumatsu* does not teach or suggest using mixtures of these two alcohols in any ratio, one of ordinary skill in the art would have no expectation of success when modifying *Mitsumatsu* in view of *Oshima*.

Contrary to the Examiner's arguments in the Answer, *Mitsumatsu* does not "explicitly suggest[] a mixture of stearyl and behenyl alcohols can be used." Answer at 7. In fact, as discussed above, the examples in *Mitsumatsu* teach formulations in which *either* stearyl alcohol or behenyl alcohol, *but never both*, are mixed with cetyl alcohol. *Mitsumatsu* at 42. The Examiner provides no explanation of why one of ordinary skill in the art, reading *Mitsumatsu* and *Oshima* in their entirety, would find a reasonable expectation of success in choosing to modify the formulation of *Mitsumatsu* to include the particular mixture in the particular ratios disclosed by *Oshima*. Because *Mitsumatsu* contains no teaching or suggestion regarding formulations in which stearyl alcohol and behenyl alcohol are mixed together, one of ordinary skill in the art would have no reasonable expectation of success when modifying *Mitsumatsu* to use a stearyl alcohol and behenyl alcohol mixture in the ratios used in *Oshima*.

In the Answer, the Examiner again ignored objective evidence of the unpredictability associated with modifying the ratio of stearyl alcohol to behenyl alcohol, stating instead that "the Oshima ratio coincides with the appellant's own ratio." Answer at 8. Appellants respectfully submit that this analysis is incorrect. As discussed in the Appeal Brief, Appellants filed a Declaration under 37 C.F.R. § 1.132 of Sandrine DECOSTER on December 1, 2008 ("the DECOSTER Declaration"), which shows the unpredictability associated with modifying the ratio of stearyl alcohol to behenyl alcohol.

The DECOSTER Declaration compares a composition with a ratio *outside* the range recited in independent claim 18 (comparative Composition AA 904 with a ratio of 0.085) to a composition with a ratio *within* the range recited in independent claim 18 (inventive Composition AA 905 with a ratio of 0.19), and demonstrates that the viscosity of inventive Composition AA 905 was found to be less temperature dependent than the viscosity of comparative Composition AA 904. See DECOSTER Declaration at 3-4. This unpredictable result of modifying the ratio of stearyl to behenyl alcohol shows that modifying *Mitsumatsu* in view of *Oshima* would not give predictable results, and thus that one of ordinary skill in the art would not have a reasonable expectation of success.

The rejection under 35 U.S.C. § 103 is therefore improper and should be reversed.

3. *Sebag Does Not Overcome the Deficiencies of Mitsumatsu and Oshima*

In the Answer, as in the Final Office Action, the Examiner argues that the use of cetylstearyl alcohol with distearyl ether in Example 1 of *Sebag* would render obvious the compatibility of distearyl ether with a mixture of stearyl alcohol and behenyl alcohol in the ratio disclosed in Appellants' independent claim 18. Answer at 9.² From this, the Examiner concludes that "it would have been obvious to a person of ordinary skill in the art to combine the components of the present invention with a reasonable expectation of success in producing a stable shampoo formulation which imparts pearlescent effect, good homogeneity, and improved stability while maintaining foaming power as well as

² The Answer and Final Office Action cite U.S. Patent No. 6,162,423 ("Sebag2") as an English equivalent of *Sebag*. See Answer at 3; Final Office Action at 3.

good hair conditioning properties." Answer at 9. Appellants respectfully disagree with this characterization of *Sebag*.

Example 1 of *Sebag* discloses use of cetylstearyl alcohol and stearyl alcohol oxyethylenated with ethylene oxide, but not stearyl alcohol alone. See *Sebag*2, col. 17, lines 36-60. No other examples in *Sebag* teach the use of stearyl alcohol in any form. Further, no examples in *Sebag* teach use of behenyl alcohol or a formulation comprising a mixture of *both* stearyl and behenyl alcohols. Contrary to the Examiner's arguments in both the Answer and Final Office Action, Appellants submit that the Examiner has offered no justification as to why one of ordinary skill in the art would have a reasonable expectation of success in modifying the stearyl alcohol and behenyl alcohol formulation of *Mitsumatsu* to include distearyl ether. Thus, *Sebag* does not make obvious a formulation comprising distearyl ether and a mixture of stearyl alcohol and behenyl alcohol in the ratio disclosed in Appellants' independent claim 18 or give one of ordinary skill in the art any reasonable expectation of success.

Further, *Sebag* does nothing to overcome the deficiencies of *Mitsumatsu* and *Oshima*, namely that one of ordinary skill in the art would not have had any reasonable expectation of success in combining these references to achieve Appellants' claimed invention. As discussed in the Appeal Brief, this is at least due to the fact that modifying the ratio of stearyl alcohol to behenyl alcohol delivers unpredictable results.

The rejection under 35 U.S.C. § 103 is therefore improper and should be reversed.

III. CONCLUSION

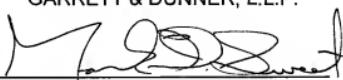
In view of the foregoing arguments as well as the arguments set forth in the Appeal Brief filed March 29, 2010, Appellants respectfully submit that the pending claims are allowable. Appellants respectfully request reversal of the outstanding § 103(a) rejection over *Mitsumatsu* in view of *Oshima* and *Sebag*.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 23, 2010

By: 
Mark D. Sweet
Reg. No. 41,469
(202) 408-4162